

Remarks

I. Status of the Claims

Upon entry of the foregoing amendment, claims 167-234 are pending in the application, with claims 167, 170, 184, 188, 191, 197, 200, 203, 206, 209, and 213 being the independent claims. Claims 86-93, 95-100, 102-123, 125-132, 158-160, and 163-166 are cancelled without prejudice to or disclaimer of the subject matter therein. New claims 167-234 are added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

II. The Amendments

Claims 86-93, 95-100, 102-123, 125-132, 158-160, and 163-166 have been cancelled without prejudice to or disclaimer of the subject matter therein. New claims 167-234 are based on cancelled claims 89-91 93, 95, 96, 98, 99, 100, 103-123, 125-132, 158-160, and 163-166, which were determined by the Examiner to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims or for which, as discussed below, the obviousness-type double patenting rejection is the only remaining rejection. Support for new claims 167-232 can be found, *inter alia*, throughout the specification and claims as originally filed. Furthermore, as indicated above, the new claims are based on the canceled claims, merely rewritten in independent form or depending from the rewritten claims. The following table shows the correspondence between the new claims and the previous, now canceled claims:

New claim(s)	Previous Claim(s)
167, 168, 169	89
170, 171, 172	90
173	91
177	98
175	93
175	89
177	95
175	105
179	89
183	103, 104
181	103
182	103
183	105
183, 189, 190	103
188	126
188, 189, 190	115
191, 192, 193	116
194	117
195	106
196	118
197, 198, 199	130
200, 201, 202	108
203, 204, 205	108
206, 207, 208	125
209, 210, 211	126
212	127
213, 214, 215	129
216	106
217	107
218	110
216	111
220	112
221	113
222	120
223	121
224	160
225	122
226, 227	123
228	131
229	132
230	159

New claim(s)	Previous Claim(s)
231	163
232	164
233	165
234	166

Accordingly, no new matter is believed to have been added by these amendments, and their entry is respectfully requested.

IV. Allowable Subject Matter

At page 7 of the Office Action of January 10, 2008, the Examiner indicated that claims 89, 91-92, 98, 100, 103, 114-119, and 130 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, claims 89, 91-92, 98, 100, 103, 114-119, and 130 have been rewritten as new independent claims or as claims that depend from the new independent claims.

III. The Rejections

A. The Rejection Under 35 U.S.C. § 112, second paragraph

At page 6 of the Office Action, claims 95, 96, and 105 have been rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Applicants respectfully traverse this rejection. In particular, the Examiner asserts that the language “at least one glycoprotein-modifying glycosyl transferase” is unclear because it is followed by two different glycosyl transferases connected with the word “and.” Applicants believe that the claim language was clear as written. However, solely in an

effort to advance prosecution, claims 95, 96, and 105 have been canceled. Thus, the rejection is moot and Applicants respectfully request that it be reconsidered and withdrawn.

B. The Rejection Under 35 U.S.C. § 102

At page 2 of the Office Action, claims 86-88, 102, 110-112, 120, 121, 123, 159, 160, 163-165, and 166 have been rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Patel *et al.* (WO 97/30087). Applicants respectfully traverse this rejection. However, solely in an effort to advance prosecution and not in acquiescence to the Examiner's rejection, claims 86-88 have been cancelled. Claims 102, 110-112, 120, 121, 123, 159, 160, 163-165, and 166 have been canceled and rewritten to depend from claims that were determined to be allowable or for which, as discussed below, the obviousness-type double patenting rejection is the only remaining rejection. Thus, the rejection under 35 U.S.C. § 102(a) is moot and Applicants respectfully request that it be reconsidered and withdrawn.

C. The Rejection for Obviousness-Type Double Patenting

At page 4 of the Office Action, claims 86-88, 90, 93, 99, 102, 104, 106-113, 120-123, 125-129, 131-132, 158-160, and 163-166 were rejected on the ground of provisional nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 228-260 of co-pending U.S. Appl. No. 10/761,435. Applicants respectfully traverse this rejection.

First, Applicants note that, solely in an effort to advance prosecution, claims 86-88, 90, 93, 99, 102, 104, 106-113, 120-123, 125-129, 131-132, 158-160, and 163-166 have been canceled. To the extent the rejection is applied to any of new claims 167-221,

Applicants respectfully traverse. First, Applicants note that the present application was filed on August 5, 2003, and is a divisional of U.S. Appl. No. 09/294,584, filed April 20, 1999. Co-pending U.S. Appl. No. 10/761,435, was filed on January 22, 2004. Therefore, the present application is the earlier-filed of the two pending applications.

If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

M.P.E.P. § 804. As Applicants believe that the claims are now in condition for allowance, the ODP rejection would be the last remaining, as claims 228-260 in co-pending U.S. Appl. No. 10/761,435 are presently withdrawn from consideration.

The Examiner has also requested confirmation that the subject application and co-pending U.S. Appl. No. 10/761,435 “were commonly owned at the time the invention in [the present] application was made, or name the prior inventor of the conflicting subject matter.” Office Action at page 5. Applicants' representative hereby confirms that the above-captioned application and co-pending U.S. Application 10/761,435 were commonly owned at the time the present invention was made.

Other Matters

At pages 6-7 of the Office Action, the Examiner has objected to the use of the term, “glycoengineering” in the claims and suggests that Applicants either use the term “glycosylation engineering” or indicate that the terms “glycoengineering” and “glycosylation engineering” have precisely the same definition. Applicants have

retained the term "glycoengineering" in the claims and confirm that the terms "glycoengineering" and "glycosylation engineering" have the same definition.

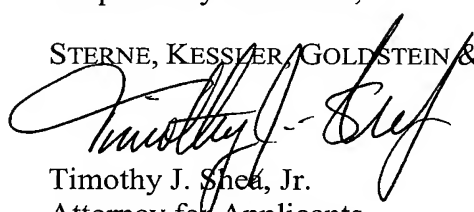
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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